REMARKS

Introduction

By this Amendment, claim 14 is cancelled, claim 25 is amended, and claim 26 is added. Claims 4-8, 10-12, 15-18 and 24-26 are pending in the present application, and were rejected by the Office Action. Applicants respectfully traverse the rejections, and in light of the above Amendment and following Remarks, request that the rejection be withdrawn.

Miscellaneous

The Office Action requested clarification regarding the structure of Fig. 1 that performs the variable feeding of the web. As illustrated by FIG. 1, any of the rolls located downstream of bobbin 24, specifically the rolls present between bobbin 24 and wrapping mechanism 29, can vary the speed of the web. It is believed that the disclosure provide in the specification and in the Figures is sufficient to teach one of ordinary skill in art how the web can be variably advanced.

Rejection under 35 U.S.C. § 112, second paragraph

The Office Action rejected claims 4-8, 10-12, 14-18, 24 and 25 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action stated that the directing step of claim 25 is not associated with the confining and advancing steps. Applicants respectfully disagree, as the directing step states that the flowable substance is applied to one side of the web, the same web of the advancing and confining steps. Nonetheless, Applicants have amended claim 25 to recite

that the flowable substance is directed "along the predetermined path" that is also recited in the confining and advancing steps. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 102(e): U.S. Patent 6,311,899 to Hidaka ("Hidaka")

The Office Action rejected claims 25, 4-8, 17-18 and 24 as anticipated by Hidaka. Applicants respectfully traverse the rejection.

Contrary to the position of the Office Action, Hidaka does not disclose the step of "confining the web to movement along a predetermined path" as required by claim 25. The sections of Hidaka cited in the Office Action do not mention a web. The invention of Hidaka is directed only to a nozzle or gun unit for applying adhesive in a spiral form.

Amended claim 25 further requires that flowable substance be discharged a rate which is a function of the speed of advancement of the web along the predetermined path. As stated in the Office Action on page 4, bottom paragraph, "[t]he patent to Hidaka lacks the control of the adhesive as a function of the web speed." Thus, Hidaka cannot anticipate present claim 25, nor dependent claims 4-6, 17-18 and 24. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. § 103: Hidaka in view of U.S. Patent 5,226,432 to Pollentzke ("Pollentzke")

Claims 10-12 and 14-16 are rejected as unpatentable over Hidaka in view of Pollentzke. Applicants respectfully traverse the rejection. Claim 14 has been cancelled and incorporated into main claim 25, thus the rejection will first be discussed with respect to claim 25.

The Office Action states that "[i]t would have been obvious to one skilled in the art to control the discharge of the adhesive of Hidaka as a function of a speed of the web." However, no support is provided for this statement. Asserting that the modification would have been obvious to one of skill in the art to try is insufficient for an obviousness rejection.

The Office Action then cites to Pollentzke to supply the disclosure that is lacking in Hidaka. First, there is no motivation to combine the two references, as Hidaka makes no mention of tobacco products. Hidaka is directed to a nozzle device for applying adhesive in a spiral form. Pollentzke is directed to a method and apparatus for making a continuous rod wherein adhesive is applied in a linear manner and the amount of adhesive applied is inversely proportional to the speed of the web.

Even if the Hidaka and Pollentzke references were combined, the combination would not result in the present invention. In Hidaka, pressurized air flow is rotated to create the non-linear pattern of applied adhesive. (See Hidaka, col. 5, lines 22-40.) If Hidaka is modified to vary the amount of adhesive as taught by Pollentzke, such that the amount of adhesive is increased as the speed of the web decreases, there would be a problem of large deposits of adhesive on the web. The excess adhesive may then contaminate the rod making or filter-tipping machines, contaminate the tobacco, and/or fail to dry properly once applied to the web, thus resulting in a defective product. In the reverse scenario, if the amount of adhesive discharged decreases as the speed of the web increases, not enough adhesive is applied, also resulting in a defective product.

It appears that the Office Action is using the disclosure of the present invention as a guide from which to locate and combine other art. This type of "picking and choosing" of elements of

the present invention from various references is impermissible hindsight bias, and is not appropriate in a § 103 rejection.

Like Hidaka, Pollentzke operates in a manner very different from that of the present invention. The Office Action focuses on the adjustable pump of Pollentzke, which works to discharge adhesive along a linear path. In contrast, the present invention utilizes a non-linear path. Also, Pollentzke discloses that as the speed of the web increases, the amount of adhesive applied decreases. (See Pollentzke, abstract; col. 4l, lines 6-8; and col. 8, lines 38-43.) The present specification, however, states that "the quantity of adhesive being supplied increases proportionally with increasing speed of the web". (See Application Specification, page 21, lines 23-25.) Figure 2 also illustrates this relationship, where the speed of the web is indicated along X-axis 70 and the quantity of adhesive indicated along Y-axis 72. Finally, claim 26 recites that the rate of discharge of the flowable substance is directly proportional to the speed of the web.

Accordingly, claim 25 is not rendered obvious by the combination of Hidaka and Pollentzke. Since claim 25 is patentable over the references, dependent claims 10-12 and 14-16 are also patentable. Additionally, Hidaka does not discharging the flowable substance from the orifice at a rate of at least 2 grams per minute, as required by present claim 16.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn.

Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims Claims 4-8, 10-12, 15-18 and 24-26 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: November 3, 2005

Kavita B. Lepping
Catherine M. Voorhees
Registration No. 33,074
Kavita B. Lepping
Registration No. 54,262
Venable LLP
P.O. Box 34385
Washington, D.C. 20004-9998
Tel.: (202) 344-4000
Telefax: (202) 344-8300